

REMARKS

In response to the Office Action dated June 6, 2007, Applicants have amended the claims, which when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration and allowance of all pending claims is respectfully requested. The amendments to the claims have been made in the interest of expediting prosecution of this case. Applicants reserve the right to prosecute the same or similar subject matter in this or another application.

Claims 1-5, 9-12 and 29 are pending in this application. By this Amendment, Claim 1 has been amended, Claims 10 and 29 have been cancelled without prejudice and new Claims 30 and 31 have been added. Support for these amendments can be found throughout the specification, e.g., page 18, lines 1-11, page 27, lines 7-9, original Claim 10 and in the working examples. Applicants respectfully submit that no new matter has been added to the subject application by this amendment. Moreover, it is submitted that the claims as now presented place the subject application in condition for immediate allowance.

The Examiner has rejected Claims 1-5 and 9-12 and 29 under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Culpon Jr. U.S. Patent No. 5,151,205 ("Culpon"). Of these claims, Claim 1 has been amended and Claims 10 and 29 have been cancelled.

Culpon discloses a lubricating oil composition containing *three essential components*: (1) a major portion of a synthetic base lubricating oil, (2) a solubilizer comprising a trimethylol propane ester of C₆ to C₁₂ carboxylic acids; and (3) 2 to 4 wt % of *a tackifier* comprising a polybutene polymer of molecular weight 100,000 to 1,000,000. According to Culpon, the

tackifier is added to the lubricating oil composition to allow the lubricant to cling to open surfaces and protect the entire assembly from rust and oxidation.

In contrast thereto, the lubricating oil composition set forth in amended Claim 1 contains “(a) a major amount of base oil of lubricating viscosity; (b) a minor deposit-inhibiting effective amount of at least one polyol ester ... (c) a diphenyl amine antioxidant ... *and wherein a tackifier is not present in the composition ...*”. Since the lubricating oil composition of amended Claim 1 does not contain a tackifier, which is an essential ingredient in the composition of Culpon to allow the lubricant to cling to open surfaces, Culpon cannot possibly anticipate amended Claim 1.

There is likewise no suggestion or motivation in Culpon of the lubricating oil composition set forth in amended Claim 1 consisting essentially of “(a) a major amount of base oil of lubricating viscosity; (b) a minor deposit-inhibiting effective amount of at least one polyol ester ... (c) a diphenyl amine antioxidant ... *and wherein a tackifier is not present in the composition ...*”. In contrast, the lubricating oil composition of Culpon specifically requires a tackifier in order to function as a chain and gear drive lubricant when contacting surfaces of the chain and gears. Applicants instead have surprisingly discovered that the presently claimed lubricating oil composition provide high antiwear, oxidation-corrosion and deposit protection in *an engine*. Thus, the lubricating oil composition as presently set forth in amended Claim 1 would not even contemplate a tackifier therein. As such, the disclosure of Culpon teaches away from the presently recited lubricating oil composition set forth in amended Claim 1.

New independent Claim 31 is believed to be allowable for at least the same reasons as amended Claim 1.

For the forgoing reasons, amended Claims 1-5, 9, 11 and 12 and new Claims 30 and 31 are believed to be patentable over Culpon and allowance of these claims is respectfully requested.

The Examiner has rejected Claims 1-5 and 9-12 and 29 under 35 U.S.C. §102(b) as being anticipated by, or, in the alternative, under 35 U.S.C. §103(a) as obvious over Field et al. International Application No. WO 99/18175 ("Field et al."). Of these claims, Claim 1 has been amended and Claims 10 and 29 have been cancelled.

Nowhere does Field et al. disclose a lubricating oil composition *consisting essentially of* "(a) a major amount of base oil of lubricating viscosity; (b) a minor deposit-inhibiting effective amount of at least one polyol ester ... (c) a diphenyl amine antioxidant; and (d) at least one additive selected from the group consisting of a metal detergent, rust inhibitor, dehazer, demulsifier, metal deactivator, friction modifier, viscosity index improver, extreme pressure agent, pour point depressant, antifoaming agent, co-solvent, package compatibiliser, metallic combustion improver, anti-knock compound, anti-icing additive, corrosion-inhibitor, ashless dispersant and dye ..." as presently recited in amended Claim 1. By employing the transitional phrase "consisting essentially of" in a composition claim, the scope of the claim is limited to the specific ingredients recited in the claim and those that do not materially affect the basic and novel characteristic(s) of the composition. *Atlas Powder Co. v. I.E. Du Pont De Nemours & Co.*, 750 F.2d 1569, 1573-74, 224 USPQ 409, 411 (Fed. Cir. 1984).

Field et al., in contrast thereto, disclose a lubricating oil composition containing *three essential components*: (1) a lubricating oil, (2) a polyol ester and (3) a *hindered phenol* as an antioxidant when an antioxidant is included in the composition. Field et al. further disclose that

if another antioxidant is present in the lubricating oil it is in addition to the one provided in accordance with the invention, i.e., the hindered phenol antioxidant (see page 12 of Field et al.). Accordingly, Field et al. cannot possibly anticipate the lubricating oil composition set forth in amended Claim 1.

There is likewise no suggestion or motivation in Field et al. of a lubricating oil composition *consisting essentially of*“(a) a major amount of base oil of lubricating viscosity; (b) a minor deposit-inhibiting effective amount of at least one polyol ester ... (c) a diphenyl amine antioxidant; and (d) at least one additive selected from the group consisting of a metal detergent, rust inhibitor, dehazer, demulsifier, metal deactivator, friction modifier, viscosity index improver, extreme pressure agent, pour point depressant, antifoaming agent, co-solvent, package compatibiliser, metallic combustion improver, anti-knock compound, anti-icing additive, corrosion-inhibitor, ashless dispersant and dye ...” as presently set forth in amended Claim 1. In contrast, as stated above, the lubricating oil composition disclosed in Field et al. must contain a *hindered phenol* as an antioxidant when an antioxidant is included in the composition. Field et al. go on to state that if another antioxidant is present in the lubricating oil it is in addition to the one provided in accordance with the invention, i.e., the hindered phenol antioxidant. Thus, it is not seen in Field et al. where there is any suggestion, motivation for or even a hint of a lubricating oil composition *consisting essentially of*“(a) a major amount of base oil of lubricating viscosity; (b) a minor deposit-inhibiting effective amount of at least one polyol ester ... (c) a diphenyl amine antioxidant; and (d) at least one additive selected from the group consisting of a metal detergent, rust inhibitor, dehazer, demulsifier, metal deactivator, friction modifier, viscosity index improver, extreme pressure agent, pour point depressant, antifoaming

agent, co-solvent, package compatibiliser, metallic combustion improver, anti-knock compound, anti-icing additive, corrosion-inhibitor, ashless dispersant and dye ..." as presently recited in amended Claim 1. Thus, Field et al. teach away from the presently recited lubricating oil composition set forth in amended Claim 1. As such, amended Claim 1 is believed to be non-obvious, and therefore patentable, over Field et al.

With respect to new Claim 31, there is no disclosure in Field et al. of a low phosphorous or phosphorous-free lubricating oil composition comprising "(a) a major amount of base oil of lubricating viscosity; (b) a minor deposit-inhibiting effective amount of at least one polyol ester ... and (c) a diphenyl amine antioxidant, and wherein a tackifier and *a hindered phenol antioxidant are not present in the composition* ..." as presently recited in new Claim 31. In contrast thereto, Field et al. must contain a hindered phenol when an antioxidant is included in the composition. Since the lubricating oil composition of new Claim 31 does not contain a hindered phenol antioxidant, which is an essential ingredient in the composition of Field et al. when an antioxidant is present therein, Field et al. cannot possibly anticipate the lubricating oil composition set forth in new Claim 31.

There is likewise no suggestion or motivation in Field et al. of a low phosphorous or phosphorous-free lubricating oil composition comprising "(a) a major amount of base oil of lubricating viscosity; (b) a minor deposit-inhibiting effective amount of at least one polyol ester ... and (c) a diphenyl amine antioxidant, and wherein a tackifier and *a hindered phenol antioxidant are not present in the composition* ..." as presently recited in new Claim 31. In contrast, the lubricating oil composition of Field et al. specifically requires a hindered phenol antioxidant when an antioxidant is included in the lubricating oil composition. The lubricating

oil composition as presently set forth in new Claim 31 does not even contemplate a hindered phenol antioxidant therein. As such, the disclosure of Field et al. teaches away from the presently recited lubricating oil composition set forth in new Claim 31.

For the forgoing reasons, amended Claims 1-5, 9, 11 and 12 and new Claims 30 and 31 are believed to be patentable over Field et al. and allowance of these claims is respectfully requested.

The Examiner has rejected Claim 29 under 35 U.S.C. §102(b) as being anticipated by Dillworth et al. U.S. Patent No. 5,958,089 ("Dillworth et al."). Claim 29 has been cancelled without prejudice. Thus, this rejection is deemed moot.

The Examiner provisionally rejected Claims 1-5, 9-12 and 29 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-46 of copending Application No. 11/046,994. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

For the foregoing reasons, amended Claims 1-5, 9, 11 and 12 and new Claims 30 and 31 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,



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